

REMARKS

Claims 1 and 3-17 are currently pending. No new matter has been added.

Applicants gratefully acknowledge the Examiner's withdrawal of the rejection of claims 1 and 3-17 under 35 U.S.C. §112, first paragraph, as lacking written description.

Rejection of Claims 1 and 3-17 under 35 U.S.C. §101

Claims 1 and 3-17 are rejected under 35 U.S.C. §101 because "the claimed invention is not supported by either a specific asserted utility or a well established utility." Specifically, the Examiner asserts that the phrase "rescuing damaged nerve cells" is non-specific.

Applicants respectfully traverse. Applicants respectfully submit that a skilled artisan at the time of the filing of the application would have reasonably understood that rescuing damaged nerve cells would be a useful process for treating disorders in a patient. For example, a skilled artisan in possession of the specification would have reasonably understood that damaged nerve cells are an appropriate target for treatment of neurodegenerative and neuromuscular diseases, as well as for the treatment of acutely damaged nerve tissue. Applicants also submit that the term "rescuing cells" is not non-specific. For example, Applicants direct the Examiner's direction to U.S. Patent Nos. 5,723,449 and 5,721,241, which are directed to methods for "rescuing" normal or uninfected cells as evidence that a skilled artisan would have understood what the term "rescuing cells" meant.

Additionally, a skilled artisan would not find the phrase "nerve cells" as non-specific because nerve cells are defined in the literature as a particular class of cells that a skilled artisan would have been familiar with. Moreover, a skilled artisan would have understood that "rescuing damaged nerve cells" refers to the reduction in the progressive loss of neurons or the stimulation of muscle re-ennervation in traumatic and non-traumatic peripheral nerve damage, as described least at page 13, lines 3-13 of the specification as originally filed.

Based at least on the foregoing, Applicants respectfully request reconsideration and withdrawal of this rejection.

Rejection of Claims 1-17 under 35 U.S.C. 112, first paragraph

Claims 1-17 are rejected under 35 U.S.C. §112, second paragraph, as failing to comply with the enablement requirement. Specifically, the Examiner asserts that "one of ordinary skill in the art would be burdened with undue experimentation to determine all neurodegenerative and neuromuscular disorders which can be treated with the claimed deprenyl compounds."

Applicants respectfully traverse. Applicants respectfully submit that the test of enablement is whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation. *In re Wands*, 858 F.2d at 737, 8 USPQ2d at 1404 (Fed. Cir. 1988). See also *United States v. Telectronics, Inc.*, 857 F.2d 778, 785, 8 USPQ2d 1217, 1223 (Fed. Cir. 1988). As the Examiner acknowledges, the level of skill of an artisan practicing the present invention is high, Applicants respectfully submit that a skilled artisan would be able to use the examples disclosed in the specification to devise appropriate experimental procedures for testing the claimed compounds for the rescue of damaged nerve cells. Moreover, the fact that experimentation may be complex does not necessarily make it undue, if the art typically engages in such experimentation. *In re Certain Limited-Charge Cell Culture Microcarriers*, 221 USPQ 1165, 1174 (*Int'l Trade Comm'n* 1983), *aff'd. sub nom.*, *Massachusetts Institute of Technology v. A.B. Fortia*, 774 F.2d 1104, 227 USPQ 428 (Fed. Cir. 1985). Accordingly, Applicants respectfully submit that the skilled artisan in possession of the specification would reasonably be able to practice the presently claimed invention.

Based at least on the foregoing, Applicants respectfully request reconsideration and withdrawal of this rejection.

Rejection of Claims 1 and 3-17 Under the Judicially Created Doctrine of Obviousness-type Double Patenting

Claims 1 and 3-17 are rejected on the grounds of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-14, 19 and 21 of U.S. Patent No. 5,844,003 (the '003 patent). Specifically, the Examiner states that "[t]he claims of the instant application are drawn to a method for rescuing damaged nerve cells in a patient using a deprenyl compound with the exclusion of certain deprenyl compounds" and that claims 1-14, 19 and 21 of the '003 patent "are directed to a method of rescuing damaged nerve cells in a patient using a specific deprenyl compounds." The Examiner concludes that "[s]uch compounds are within the scope of the claimed compounds."

Applicants respectfully submit that, while in no way admitting that the present claims are obvious over claims 1-14, 19 and 21 of U.S. Patent No. 5,844,003, upon allowance of the present claims, Applicants will consider submitting a terminal disclaimer in compliance with 37 C.F.R. 1.321(b) and (c), if appropriate, which will obviate the rejection.

Application No.: 10/686496
Examiner: Z.A. Fay

Docket No.: IFM-001CPCN5
Group Art Unit: 1618

Rejection of Claims 1 and 3-17 Under 35 U.S.C. §102(b)

Claims 1 and 3-17 are rejected under 35 U.S.C. §102(b) as being anticipated by Tatton *et al.* (U.S. Patent No. 5,844,003, hereinafter "the '003 patent"). Specifically, the Examiner asserts that Tatton *et al.* teach the use of the deprenyl compounds for rescuing damaged nerve cells in a patient. The Examiner further asserts that Tatton *et al.* "makes clear that the claimed method of use is old and well known."

Applicants respectfully submit that the present application claims priority to the '003 patent, as evidenced by the Application Data Sheet submitted to the Office on October 14, 2003. According, in view of the foregoing, Applicants respectfully request reconsideration and withdrawal of this rejection.

SUMMARY

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. If there are any remaining issues or the Examiner believes that a telephone conversation with Applicants' Attorney would be helpful in expediting prosecution of this application, the Examiner is invited to call the undersigned at (617) 227-7400.

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Respectfully submitted,

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